

REMARKS

In considering the status of the present application, certain claims were allowed, i.e., claims 1 – 23, 33 – 36, 38 74, 75 and 77.

Regarding original claims 1 – 23, they are attached as Exhibit A to this Amendment.

Concerning the rejected claims, they were rejected on the following basis:

1. Recapture
2. Indefiniteness 35 USC 112
3. Prior art.

In view of the number of claims under consideration, attached hereto as Exhibit B is a claim chart which sets forth all of the claims (except the original claims) which are still active in this application.

Adjacent each claim are (1) an indication as to whether the claim was independent or dependent, (2) whether the “means for” language of the last paragraph of 35 USC 112 is included in the claim, (3) whether the language suggested by the Examiner to avoid recapture is in the claim, and (4) special remarks relating to the claim.

In reviewing the rejected claims which were not rejected on prior art, it may be noted that claims 37, 43 – 47, 43, 47, 67, 69, 71, 72, 73, 76, 78 – 85 now all include the “anti-recapture” language suggested in the Office Action, and also the “means for” language of the sixth paragraph of 35 USC 112. Each claim has, in parentheses, an indication as to whether it was amended by the present amendment. In addition, in the “Claim Analysis Sheet” the “X” marks indicate whether or not the “means for” and the “Recapture” limitations are included in each claim. The “Claim Analysis sheet” also indicates whether each claim is independent or dependent.

In view of the amendments to the claims listed in the preceding paragraph, it is presumed that these claims are now allowable.

Indefiniteness

All rejected claims now include the “means for” language authorized by the sixth paragraph of 35 USC 112, so it is believed that this rejection is no longer applicable.

Recapture

Regarding "recapture", it is respectfully noted that we do not have the simple situation of claims which are the same as cancelled claims. Instead we have the situation where the claims under consideration, specifically, claims 39, 42, 48, 49, 50 and 70 are slightly broader in some areas and are more restricted in other areas.

In this regard we are attaching an extract from Section 1412.02 of the MPEP, as follows:

**REISSUE CLAIMS ARE BROADER IN SCOPE
IN SOME ASPECTS, BUT NARROWER IN
OTHERS:**

Reissue claims that are broader in certain aspects and narrower in others *vis-à-vis* claims canceled from the original application to obtain a patent may avoid the effect of the recapture rule if the claims are broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). "[I]f the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; [i]f the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible." *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

If the broadening aspect of the reissue claim relates to subject matter previously surrendered, the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter. If the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of the surrendered subject matter, then there is no recapture. In this situation, even though a rejection based on recapture is not made, the examiner should make of record the reason(s) why, as a result of the narrowing limitation, there is no recapture.

In reviewing each of claims 39, 42, 48, 49, 50 and 70, they all include detailed subject matter not included in the claims cancelled from the original prosecution of the parent

application. In addition to other differences, note that all of these claims include “means for providing a multiplicity of sections that sway laterally to a substantial extent independently of one-another in response to forces applied to the foot...”.

This underlined limitation was not in any of the cancelled claims and is clearly one aspect of the invention which merits consideration as a limitation of the claims making them significantly narrower in this regard than the cancelled claims.

Now, to quote from our last amendment:

“Accordingly, we have a situation similar to that present in the *Ball Corp. v. U.S.* decision cited in the Office Action, in which claim 58 (and the other claims) is broader in some respects and significantly narrower in some important respects as compared with claims dropped or amended in the file history of the parent application and patent..

In the Ball reissue case the inventor omitted one structural limitation which had been included in the patent prosecution, but added new structural limitations including dielectric material and an electrical signal feed assembly. Similarly, in the present case, claim 58 and other claims include new and important structural limitations not involved in the file history limitations. Accordingly, guided by the Ball case, none of the present claims as amended should be barred by the recapture doctrine.

It is also noted in passing that the Clement case involves a different type of situation where the reissue tried to broaden the temperature range, which had been limited during prosecution, without significantly narrowing the claims in other areas.

It is also respectfully submitted that, where the basic reissue statute contemplates that broadened reissue claims are generally permitted, the suggestion that a limitation added to one claim (claim 17) in the parent case must be included in all reissue claims, is clearly improper. Here, where each claim under consideration includes important limitations not present in any original claim, rejection on the basis of recapture is inappropriate.”

It is further noted that each of these 6 claims includes other limitations which further distinguish from claims cancelled in the parent application. Accordingly it is respectfully requested that the recapture rejections be withdrawn.

Prior Art Rejections

Claim 50 and dependent claims 54 – 56 were rejected on the combination of Kellerman in view of Andrews. As mentioned in the prior amendment, one would have to turn these references upside-down in order to make a valid anticipation combination of references. Note that claim 50 calls for the upper surfaces of the inserts to be “soft and resilient”, whereas Kellerman states over and over again that he wants a hard slippery surface for low friction engagement with the foot. It is also noted that the claims calls for “means for providing a multiplicity that sway laterally to a substantial extent...” This construction is clearly not shown by Kellerman or Andrews; and it is only through hindsight and the teachings of applicant that the rejection could be made.

Accordingly the allowance of claim 50 and associated dependent claims is clearly in order and is solicited.

Concerning new claims 82 – 85, claim 82 is dependent on allowed claim 77 and should be allowable with it. Regarding claims 83, 84 and 85, as indicated on the attached chart, they are based on claims 58, 67 and 70, respectively, and include amendments to overcome both the indefiniteness and the recapture rejections as suggested in the Office Action. Accordingly the allowance of these claims is appropriate and is solicited.

Concerning the Supplemental Declaration of Kelly M. Long, it was filed as a result of criticisms in the Office Action of the original previously submitted Declaration of Kelly Long, and supplied the requested information. Now, further objections are being raised. In this regard, it is respectfully requested that the two Declarations be accepted for their contents. Note particularly paragraph 5 of the Supplemental Declaration to the effect that products including the invention had “an unusually rapid acceptance and increased sales growth”. Further, Ms. Long asserts that in her opinion, the merits of the invention as confirmed by this identified tests were a very significant factor in the high sales figures. We consider these facts involving commercial success to be important secondary factors to be considered relative to patentability in accordance with U.S. Supreme Court decisions.

It is also noted in passing that the reissue claims are all presented in underlined format, with an indication at the beginning of each claim as to whether it is being amended by the present amendment. In addition, the amendments to existing claims which have been made by this amendment were to bring in the language suggested by the Examiner to either (1) overcome

the indefiniteness rejection, or (2) bring in the language suggested by the Examiner to overcome the recapture rejection.

In the event that this patent application is not considered to be entirely in condition for allowance, it would be appreciated if the Examiner would grant a telephone interview. Applicant's attorney would prefer a personal interview with the Examiner, but is located in Los Angeles so that a personal interview is not practical. Accordingly, a comparable telephone interview would be appreciated if the application is not considered allowable. Thank you.

Concerning one minor matter, the reissue declarations are being solicited from the inventors. Now that some claims have been allowed, the Declarations are being given appropriate attention.

Applicant hereby authorizes the Commissioner to charge any additional fees, which may be required, or credit any overpayment to Deposit Account No. 06-2425. Should such additional fees be associated with an extension of time, Applicant respectfully requests that this paper be considered a petition therefore.

Respectfully submitted,



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Enclosures:

- (1) Exhibit A (patent claims 1 - 23)
- (2) Exhibit B (Claim analysis)